

**REMARKS:**

Claims 6-10 and 36-41 are pending in the present application.

In response to the Office Action dated June 15, 2004, Applicants have first cancelled claim 42 and amended independent claims 6 and 36 to address the Examiner's § 112 concerns. Regardless of the Examiner's ultimate conclusions regarding the obviousness issues (as discussed below), Applicants respectfully submit that entry of the claim amendments will place the application in better form for appeal.

Reviewing the specific amendments to claims 6 and 36, Applicants have re-organized the steps of each method claim, adding a specific step of "providing a plurality of articles, each article...having an individual identification code on a surface thereof...." Applicants point out that similar language was originally included in the preambles of the respective claims and thus does not materially alter the scope of the claims. Applicants have also separated the "arranging" and "wrapping" steps to clarify the sequence of the method steps in each claim, as recommended by the Examiner.

Finally, with respect to both claims 6 and 36, the Examiner has asserted that "the method as claimed cannot be realized if...none of the individual identification code[s] is visible." This is an inaccurate characterization of the claimed invention. Quite to the contrary, it is the express intent of the present invention to substantially obscure all individual identification codes of the articles of a bundle, thus preventing an automated scanner from reading any of the individual identification codes and identifying the bundle as a single article. If automated identification of the bundle is desired, a bundle identification code is applied to the sleeve around the bundle of articles, as recited in dependent claims 10 and 41.

With respect to the continuing rejection of the claims as being obvious pursuant to 35 U.S.C. § 103, Applicants agree with the Examiner's conclusion that the primary distinction between the admitted prior art (referred to in the Office Action as "AAPA") and the claimed invention is the partial wrapping of the bundle with a dark-colored, opaque, or patterned film in order to obscure the individual identification codes of the articles in the bundle. Specifically, the claimed method uses two distinct films in wrapping the bundle of articles: (1) a first, substantially transparent film, and (2) a second film capable of obscuring identification codes, with the films partially secured to one another to form a sleeve around the articles. The sleeve formed by the two films avoids completely visually obscuring the product information on the articles in that certain advertising indicia or other product information remains viewable, while the second film obscures the individual identification codes on the articles.

Although U.S. Patent No. 4,827,114 issued to Blanchon describes a process for bundling articles such that the individual identification codes are obscured, only a single film is used. Similar to the AAPA, Blanchon fails to teach or suggest the use of two distinct films in a method of bundling articles, the partial wrapping of each film around the articles being bundled, and securing the first film to the second film to form a sleeve.

In this recent Office Action, the Examiner therefore points to U.S. Patent No. 4,586,312 issued to Limousin as a reference teaching the use of two films to wrap a bundle of articles. However, this reference includes no teaching or suggestion for obscuring the individual identification codes of the bundles articles. Quite to the contrary, the sleeve formed by the two films includes a removable access panel "for enabling price markers to be placed on each of the plurality of article means 10A-10L." See column 5; lines 13-15.

It is a fundamental precept of patent law that “[w]hen an obviousness determination relies on the combination of two or more references, there must be some suggestion or motivation to combine the references.” WMS Gaming Inc. v. International Game Technology, 51 USPQ2d 1385, 1397 (Fed. Cir. 1999). See also In re Rouffet, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998); In re Oetiker, 24 USPQ2d 1443, 1446 (Fed. Cir. 1992); Diversitech Corp. v. Century Steps, Inc., 850 F.2d 675, 678-79, 7 USPQ2d 1315, 1318 (Fed. Cir. 1988); In re Geiger, 815 F.2d 686, 687, 2 USPQ2d 1276, 1278 (Fed. Cir. 1987); and Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1147, 227 USPQ 543, 551 (Fed. Cir. 1985).

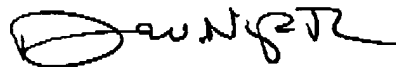
In this particular case, there is no such suggestion or motivation for combining the references. As mentioned above, the AAPA provides no teaching or suggestion for the partial wrapping of the bundle with a dark-colored, opaque, or patterned film, in order to obscure the individual identification codes of the articles in the bundle. Although Blanchon describes a process for bundling articles such that the individual identification codes are obscured, Blanchon fails to teach or suggest the use of two distinct films in a method of bundling articles, the partial wrapping of each film around the articles being bundled, and securing the first film to the second film to form a sleeve. Finally, although Limousin teach a two-film construction for a sleeve, there is no suggestion or identified need for obscuring individual identification codes.

Accordingly, the only teaching that supports the combination of the various prior art references is found in the present application. This is a classic case of hindsight reconstruction in which the present patent application has been used as “a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit.”” Orthopedic Equip. Co. v. United States, 702 F.2d 1005, 1012, 217 USPQ 193,

199 (Fed. Cir. 1983). In short, it is the present application that contemplates and describes the use two distinct films in wrapping the bundle of articles: (1) a first, substantially transparent film, and (2) a second film capable of obscuring identification codes, with the films partially secured to one another to form a sleeve around the articles. The sleeve formed by the two films avoids completely visually obscuring the product information on the articles in that certain advertising indicia or other product information remains viewable, while the second film obscures the individual identification codes on the articles.

In light of the foregoing amendments and remarks, Applicants respectfully request allowance of all claims now pending in this Application. Again, regardless of the Examiner's ultimate conclusions regarding the obviousness issues, Applicants respectfully submit that entry of the claim amendments will place the application in better form for appeal.

Respectfully submitted, .



David W. Nagle, Reg. No. 42,923  
Mandy V. Wilson, Reg. No. 53,781  
**STITES & HARBISON, PLLC**  
400 W. Market Street  
Louisville, Kentucky 40202-3352  
Phone (502) 587-3400  
Facsimile (502) 587-6391